

REMARKS/ARGUMENTS

Claims 1-28 were pending. Restricted claims 1-23 have been cancelled without prejudice to refiling. Claim 24 has been amended. Reexamination and reconsideration of the claims, as amended, are respectfully requested.

The claims were provisionally rejected for Double Patenting over copending, commonly owned application no. 10/409,409. This Double Patenting rejection has been overcome by submission of a Terminal Disclaimer.

Claims 24-28 were rejected as being anticipated by U.S. Patent No. 5,645,420, to Bergersen. Such rejections are traversed in part and overcome in part.

The Bergersen '420 patent describes generally what is referred to as a "positioner" in the orthodontic arts. A positioner is a rather soft mouthpiece having at least one upper or lower trough for receiving the patient's upper or lower dentition, where the patient bites into the positioner to apply force to reposition the teeth in a desired way. The Examiner relies on "protrusion" 60 in Figs. 6-9 as teaching a protrusion intended "to assist in holding the appliance in position" which contacts "a tooth along at least a portion of its gingival margin . . . and interdental areas."

Applicants respectfully disagree with this interpretation of the teachings of Bergersen '420. Region 60 in Figs. 6-9 is a "moldable material" which has been introduced into the tooth depressions 58 of the positioner. Nowhere is it taught or suggested that the protrusion intended to contact a tooth at an interdental area or along its gingival margin (claims 2 and 3). Indeed, it is specifically taught that the material 60 "is trimmed at the margins of the tooth depressions (col. 7, lines 57-58)." Thus, since the material is cut away, it would not be available to contact the gingival margins.

Applicants further disagree with the Examiner's reliance on the passage at col. 7, line 48, as teaching that the material 60 "contacts at least one tooth to assist in holding the

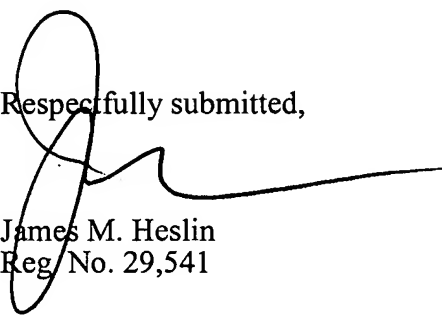
appliance in position." That passage, in contrast, actually teaches that the material reshapes "selected tooth depressions 58 exactly to the contour of their respective teeth, to thereby firmly hold those selected teeth in a precise position." Thus, the material is not intended to hold the positioner in position (which is unnecessary since the patient will be biting down), but rather holds the teeth in the precisely selected position during the tooth alignment procedure.

In an effort to even further distinguish the teachings of Bergersen '420, Applicants have amended claim 24 to recite that the claimed protrusion is disposed "along an edge of the hollow cavity" of the elastic positioning appliance shell. This is directly contrary to the teachings of Bergersen '420 which teaches that the material 60 is to be coated over the tooth receptacles and trimmed away from the gingival margins.

In view of the above amendments and remarks, Applicants believe that all pending claims are in condition for allowance and request that the application be passed to issue at an early date.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 650-326-2400.

Respectfully submitted,


James M. Heslin
Reg. No. 29,541

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300

Attachments: *Provisional Terminal Disclaimer USSN 10/409,409*

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